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WILMER CUTLER PICKERING HALE AND DORR LLP
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EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/720,821
Filing Date: November 24, 2003
Appellant(s): WILSON, DOUGLAS B.

Wayne M. Kennard
For Appellant

**SUPPLEMENTAL
EXAMINER'S ANSWER**

This is in response to the appeal brief filed October 31, 2006 appealing from the Office action mailed May 9, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

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The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal: related appeal of copending Application No. 10727306 as listed by Appellant.

(3) Status of claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments after Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of claimed subject matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of rejection to be reviewed on appeal

The Appellant's statement of the grounds of rejection to be reviewed on appeal in the brief is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence relied upon in the rejection of claims under appeal.

2,118,540	Van Arsdel	May 24, 1938
2,134,020	Anson	October 25, 1938
1,575,848	Laubach	March 9, 1926

(9) Grounds of rejection

The following grounds of rejection are applicable to the appealed claims:

A. Claims 20-26 and 28/20 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Arsdel (US Patent No. 2,118,540).

Regarding claim 20, Van Arsdel teaches a fatigue relieving/preventing apparatus associated with a steering wheel 3 for controlling a vehicle comprising:

a first section 4 (*i.e.*, horizontal section in Fig. 3) that connects to a peripheral portion 3 of the steering wheel 3; and

a second section 2 (*i.e.*, a concave upward section in Figs. 3 and 5) that connects to and extends from the first section 4 at the peripheral portion 3 of the steering wheel 3, the second section 2 extends from the first section 4 outward at an angle (see angle α in Figs. 3 and 5 of the Attachment 1) to a plane (Att. 1) across a face to the steering wheel 3, with the second section 2 for supporting at least a portion of a vehicular operator's body (e.g., the hand as seen in Figs. 1 and 2). *Ibid.* right column on page 1, lines 29-54.

Claim 20 and other claims below are anticipated by Van Arsdel because Van Arsdel teaches each and every positively claimed element. It is well settled that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than functions. MPEP 2114 cited *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). In addition, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art

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apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. Inter. 1987) cited in MPEP 2114, *supra*.

Regarding claim 21, the second section 2 is inherently deformable in at least one direction when deforming pressure is applied to such second section 2. Note that virtually anything will be deformed if enough pressure is applied to it. See the term “flexible” in *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC 1969).

Regarding claim 22, the second section 2 supports a portion of the vehicular operator's body when pressure from such body portion is applied in at least one direction.

Regarding claim 23, the steering wheel includes a steering wheel for controlling at least a nautical vessel, an aircraft, or a ground transportation vehicle.

Regarding claim 24, the second section 2 will inherently return to an original first position after deforming pressure is removed therefrom.

Regarding claim 25, the portion of the body supported by the second section includes at least a forearm, wrist, or hand.

Regarding claim 26, the first section 4 extends a length of a predetermined peripheral portion of the steering wheel 3.

Regarding claim 28/20, the first section 4 is inherently deformable. See the term “flexible” in *Fredman v. Harris-Hub Co., Inc.*, *supra*.

B. Claims 20-26 and 28/20 are rejected under 35 U.S.C. 102(b) as being anticipated by Anson (US Patent No. 2,134,020).

Regarding claim 20, Anson teaches a fatigue relieving/preventing apparatus associated with a steering wheel 10 for controlling a vehicle comprising:

a first section 13 that connects to a peripheral portion of the steering wheel 10;

a second section 11 extends from the first section at the peripheral portion of the steering wheel 10, the second section 11 extends from the first section 13 outward at an angle (see angle α in Fig. 8 of Attachment 2) to a plane (Att. 2) across a face (Att. 2) to the steering wheel 3, the second section 11 for supporting at least a portion of a vehicular operator's body (e.g., the hand) when pressure from the portion of the vehicular operator's body on the second section 11 is less than the pressure for deforming the second section 11 out of interference with the vehicular operator's ability to operate the steering wheel 10, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 10 when pressure from the portion of the vehicular operator's body on the second section 11 is equal to or greater than the pressure for deforming the second section 11 out of interference with the vehicular operator's ability to operate the steering wheel 10.

Anson's fatigue relieving/preventing apparatus is made of a flexible material such as rubber or a similar pliable composition material. See, e.g., page 1, right column, lines 49-53, and page 2, right column, lines 25-40. Therefore, the second section 11 of Anson's apparatus is deformable as claimed.

Regarding claim 21, the second section 11 is deformable in at least one direction when deforming pressure is applied to such second section 11 since it is made of a flexible material such as rubber. *Ibid.* right column on page 1, lines 46-53. On the other hand, note that virtually anything will be deformed if enough pressure is applied to it. See the term "flexible" in *Fredman v. Harris-Hub Co., Inc., supra*.

Regarding claim 22, the second section 11 supports a portion of the vehicular operator's body when pressure from such body portion is applied in at least one direction.

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Regarding claim 23, the steering wheel 10 includes a steering wheel for controlling at least a nautical vessel, an aircraft, or a ground transportation vehicle.

Regarding claim 24, the second section 11 will return to an original first position after deforming pressure is removed therefrom since it is made of a flexible material such as rubber. *Ibid.* right column on page 1, lines 46-53.

Regarding claim 25, the portion of the body supported by the second section includes at least a forearm, wrist, or hand.

Regarding claim 26, the first section 13 extends a length of a predetermined peripheral portion of the steering wheel 10.

Regarding claim 28/20, the first section 13 is deformable since it is made of a flexible material such as rubber. *Ibid.* left column on page 2, lines 19-34. See also the term “flexible” in *Fredman v. Harris-Hub Co., Inc., supra.*

C. Claims 20, 27, 28/20, and 28/27 are rejected under 35 U.S.C. 102(b) as being anticipated by Laubach (US Patent No. 1,575,848).

Regarding claim 20, Laubach teaches a fatigue relieving/preventing apparatus associated with a steering wheel 1 for controlling a vehicle comprising:

a first section 7, 8 that connects to a peripheral portion of the steering wheel 1;

a second section 10 that connects to, and extends from, the first section 7, 8 at the peripheral portion of the steering wheel 1, the second section 10 extends from the first section 7, 8 outward at an angle (see angle α in Fig. 2 of the Attachment 3) to a plane (Att. 3) across a face (Att. 3) to the steering wheel 1, the second section 10 for supporting at least a portion of a vehicular operator's body (*e.g.*, the hand).

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Claim 20 and other claims below are anticipated by Laubach because Laubach teaches each and every positively claimed element. It is well settled that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Schreiber, supra*. In addition, a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham, supra*.

Regarding claim 27, the second section 10 includes at least two second sections 10 that each connects to the first section 7, 8 at separate locations (by comparing Applicant’s Fig. 2 with Laubach’s Fig. 1).

Regarding claims 28/20 and 28/27, the first section 10 is inherently deformable. See the term “flexible” in *Fredman v. Harris-Hub Co., Inc., supra*.

(10) Response to argument

A. General

The Examiner respectfully submits:

As noted in MPEP 2111, during patent examination, *claims are given their broadest reasonable interpretation consistent with the specification*. It is proper to use the specification to interpret what the Appellant meant by a word or phrase recited in the claim. However, *it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim*. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); and *Intervet America Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989). (Emphasis added).

B. Van Arsdel

At the outset, Appellant's arguments are not based on the limitations appearing in the claims. *In re Self*, 213 USPQ 1, 5 (CCPA 1982). In fact, Appellant's claim 20 recites "*a second section* that connects to, and extends from, the first section at the peripheral portion of the steering wheel, the second section extends from the first section outward at an angle to a plane across a face to the steering wheel." It is clear from claim 20 that it requires the second section of the handgrip, *not* the handgrip *per se*, extends from the first section outward at an angle to the plane across the face of the steering wheel. Therefore, Appellant's contention that the grip rest of Van Arsdel is in a plane parallel with the one across the face of the steering wheel on page 6 of the brief is immaterial to the patentability of the claim. The issue is not whether Arsdel's grip rest is disposed at an angle relative to the plane across the face of the steering wheel. Rather, the issue is whether Arsdel teaches the second section that connects to and extends from the first section outward at an angle relative to the plane across the face of the steering wheel.

In the case at hand, on page 1, right column, lines 13-28, Arsdel describes: "[t]he grip rest 2 is *concave* longitudinally and about half of the rest extends over and part way across the steering wheel rim 3 in a manner to slope downwardly and inwardly of the rim. The outer edge 4 of the side, and 5 of the rear end of the *concave*, located above the rim, *extends up into a marginal flange* to be contacted by the inside of the ball of the thumb or by the bottom of the hand, depending upon which part of the hand is seated to rest." See also Arsdel's claims 1 and 2. Arsdel's concave upward section 2 extends from the first section 4 outward at an angle α to the plane across the face of the steering wheel as seen in Figs. 3 and 8 of Attachment 1. Therefore,

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Arsdel's concave upward section 2 in Fig. 3 of Arsdel "reads on" Appellant's claimed second section.

In addition, Appellant's contention that "[o]nce the grip-rest of Van Arsdel is in place, it is *fixed*, and does not move" is unsupported by substantial evidence in the record. Indeed, on page 1, right column, line 49 through line 2, left column, page 2, Arsdel expressly describes:

My improved grip-rest may be formed integrally with the rim of the steering wheel as shown in Fig. 8, but I prefer to make it *removable* as an attachment for any make of car and also to make it *adjustable* to suit the requirements or fancy of the driver. (Emphasis added).

Particularly, Appellant's contention is in direct conflict with Arsdel's description on page 2, left column, lines 28-32:

The grip rest *may be shifted* along the length of the rim, or vertically around it by reversing the screw sufficiently to permit *change of the rest to the new position*, where it will be held again by tightening up on the screw. (Emphasis added).

Simply put, Arsdel explicitly teaches that the driver may loosen the screw 14 in Fig. 6 so that it is *deformable* in order that the driver can put extensive pressure on it and *it will move* for steering the automobile.

The support in the description of Arsdel that it will deform out of the interference with the operation of the steering wheel is on page 2, left column, lines 28-32. By loosening or reversing the screw 14 sufficiently to permit Arsdel's second section 2 shifted or vertically around the rim 3, the second section can be at the new position wherein the second section does not interfere with the operation of the steering wheel to suit the requirements or fancy of the driver.

Anson

On pages 8-10 of the brief, the thrust of Appellant's arguments is that Anson is missing at least the deforming element of claim 20. See first paragraph on page 10 of the brief.

The instant assertion is likewise unsupported by substantial evidence in the record. In fact, Anson's grip is made of flexible or semi-rigid material, therefore, Anson's grip is deformable or deflectable out of interference with the vehicular operator's ability to operate the steering wheel, *i.e.*, out of the normal position. See page 2, right column, lines 25-40, quoted below:

In the modification illustrated in Figs. 4 and 6, neck 12 is constructed of a rubber composition having the same desired characteristics of pliability and semi-rigidity described in connection with the form illustrated in Figs. 1 and 2 and described above. The hand grip portion 11, however, may be made of solid material such as metal, and is detachably connected to neck 12. While this modification does not possess the degree of hand gripping comfort inherent in the principal modification, nevertheless, by virtue of the pliability and semi-rigidity of the neck portion; this type of attachment will also provide the advantages of *ready deflection from the normal position* while affording positive control of the wheel movements. (Emphasis added).

In addition, on page 1, left column, line 48 through line 32, right column, Anson expressly describes: "a means for attachment to the steering wheel, whereby *the device may be readily attached to, or removed from, the wheel, and which may be quickly and easily shifted to various positions on the wheel as dictated by the degree of driving comfort desired.*"

Particularly, on page 2, left column, lines 62-72, Anson teaches:

At the same time, if it becomes desirable to move the attachment to a different position on the wheel rim, a slight movement of the grip portion toward the wheel rim will loosen the contact of strap 13 therewith, and the attachment can then be easily shifted to some other position on the wheel. Similarly, *the attachment may be rotated about the wheel rim* from its normal

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pendent position to *a position within the periphery of the wheel* when it becomes desirable to dispense with its use in operating the wheel. (Emphasis added).

As evidenced in the above quotation, Anson explicitly states that the driver may rotate Anson's attachment/handgrip about the wheel rim 10 to a position within the periphery of the wheel, *i.e.*, to a position shown in Appellant's Fig. 4 when the driver so desires. Anson's description above reveals that Anson-type-attachment is operated in a similar manner to what is claimed in claim 20. As such, a person of ordinary skill in the art would find that there is a teaching in Anson in which the hands are or other body part is supported by Anson attachment as set forth in claim 20.

Further, since Anson's *attachment may be rotated about the wheel rim* from its normal pendent position to *a position within the periphery of the wheel* when it becomes desirable to dispense with its use in operating the wheel, Anson's attachment is capable to be rotated outward such that the second section 11 is at an angle from the plane across the face of the steering wheel and out of interference with the operation of the steering wheel as claimed. On the other hand, it is well settled that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham, supra*.

In the case at hand, Anson teaches all structural limitations in the claims, therefore, Appellant's contention regarding the manner in which the claimed device is intended to be employed is unpersuasive.

Laubach

Appellant contended that the knobs of Laubach are rigidly connected to the steering wheel by the screws 5, thus, the knobs are meant remain in place in operation. Nevertheless, common sense teaches that the driver can unscrew Laubach's screws 5, and then screw or fasten the screws 5 at other position on the rim 6 of the steering wheel as the driver so desires. In other words, the position of Laubach's knobs is capable of being changed. As such, Laubach's knobs inherently are capable to perform the functions recited in Appellant's claim. *In re Schreiber, supra.*

Appellant further asserted that the knob of Laubach does not deform out of interference with the operation of the steering wheel as set forth in claim 20. The Examiner respectfully submits that the driver can unscrew Laubach's screws 5, and then screw or fasten the screws 5 at other position on the rim 6 of the steering wheel such that the new position is out of interference with the operation of the steering wheel as the driver so desires. The operation to adjust or change the position of Laubach's handgrips is similar to the operation to adjust the handgrip of Arsdel since both Laubach and Arsdel use the screws as the fastening means. Since the position of Laubach's knobs is capable of being changed to be out of interference with the operation of the steering wheel, *i.e.*, Laubach's knobs can inherently performed the functions recited in Appellant's claim, therefore, Appellant's claims are anticipated by Laubach. *In re Schreiber; Ex parte Masham*; and MPEP 2114, *supra.*

(11) Related Proceeding(s) Appendix

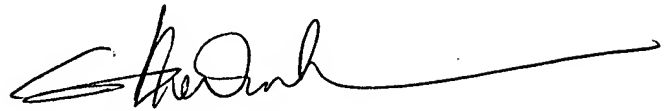
No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

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CONCLUSION

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Vinh T. Luong
Primary Examiner

Conferees on September 11, 2006:

Supervisor of Patent Examiners Richard Ridley



Primary Examiner Charles Marcus



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ATTACHMENT 1

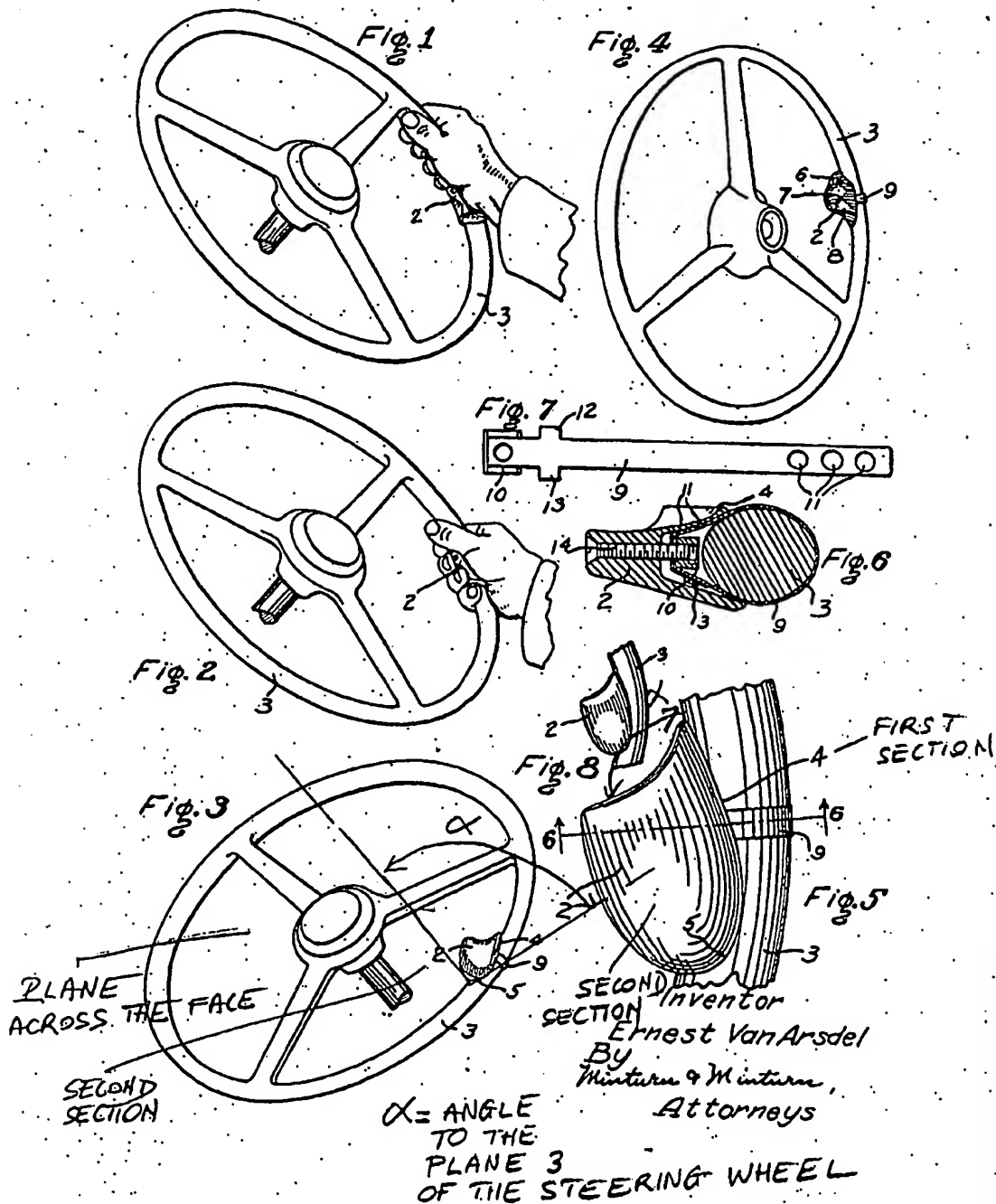
May 24, 1938.

E. VAN ARSDEL

2,118,540

AUTO STEERING WHEEL HANDGRIP

Filed May 10, 1937



ATTACHMENT 2

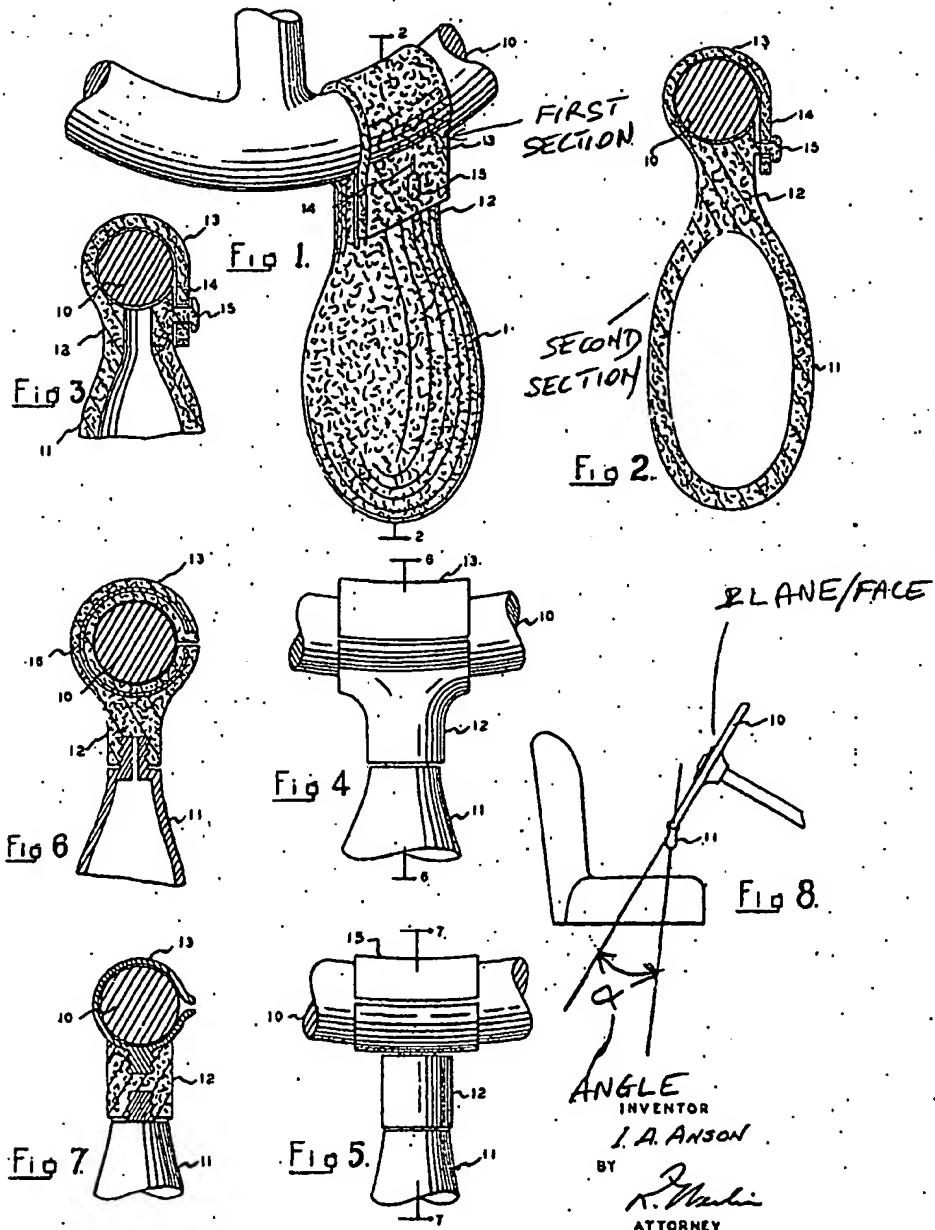
Oct. 25, 1938.

I. A. ANSON

2,134,020

STEERING WHEEL ATTACHMENT

Filed Sept. 30, 1937



ATTACHMENT 3

March 9, 1926.

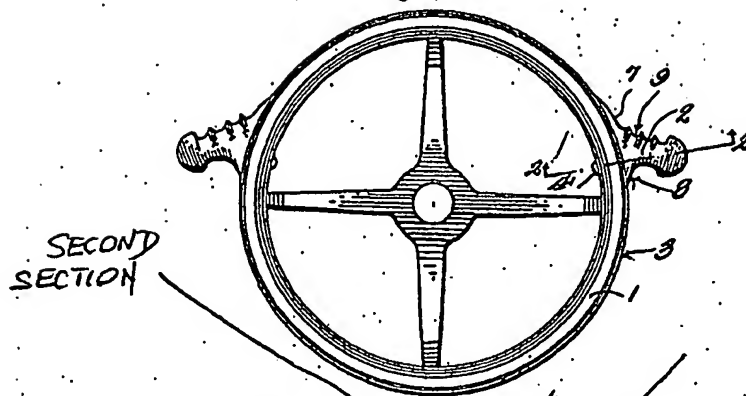
C. E. E. LAUBACH

STEERING WHEEL

Filed July 13, 1925

1,575,848

Fig. 1.

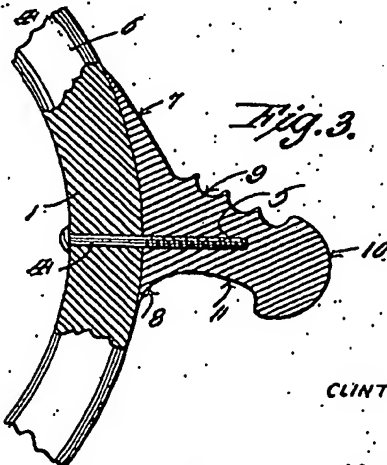


PLANE/FACE

Fig. 2



Fig. 3.



WITNESSES

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